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PATENT & TRADEMARK OFFICE

Our ref: KOY-9 Client's ref: F0893-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of: Y. USAGAWA et al: Art Unit : 1752

Serial No. : 10/686,062 :

Examiner : T. Chea

Filed : October 15, 2003 :

Title : PHOTOTHERMOGRAPHIC IMAGING MATERIAL :

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DECLARATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, Narito Goto, hereby declare and say as follows:

1. I am a named co-inventor of the above-identified Application.

2. I received a Master's degree in chemistry from Tokyo University in 1979. Since 1979, I have been employed by Konica Corporation (now Konica Minolta Holdings, Inc.), the Assignee of this Application. During my employment at Konica, I have engaged in the research and study of photosensitive materials.

3. I provided a Declaration dated April 22, 2005 (April Declaration) in this Application. It is my understanding that the Examiner criticized the April Declaration because the photothermographic material reported in the April Declaration were not prepared according to the samples disclosed in the applied prior art of record. It is also my understanding that the applied prior art of record is U.S. Patent No. 6,413,712 (Yoshioka), U.S. Patent No. 6,586,170 (Yamada), and U.S. Patent No. 5,686,228 (Murray). It is also my understanding that the Examiner has stated that both Yoshioka and Yamada disclose a photothermographic material substantially as claimed and that Murray was cited to teach a compound of Formula (1).

4. It is my opinion that the procedures for preparation of photothermographic materials as taught in both Yoshioka and Yamada are similar enough to the procedure taught in the present Invention, with the exception of some specific chemical compounds such as a compound of formula (1) or a compound of formula (2a) that the results reported in the April Declaration are a fair representation of the results that can be expected if the same tests were performed starting with the prior art formulations.

5. I am also of the opinion that results obtained from material made by starting with Yoshioka or Yamada would be similar to the results reported in the April Declaration.

6. In order to demonstrate the similarity between the procedure employed in the April Declaration for making the photothermographic material and the procedure employed in both Yoshioka and Yamada, I have outlined below all three procedures. As can be seen, all three procedures are similar.

OUTLINE OF PROCEDURES TO MAKE PHOTOTHERMOGRAPHIC MATERIAL IN THE APRIL DECLARATION, YOSHIOKA AND YAMADA

7. In the April Declaration, Example 1, as recited on pages 242-249 of the Application, was employed. For comparison, I have chosen the procedure described in Yoshioka at Column 38, line 30 - Column 46, line 52.

For Yamada, I have chosen Example 2 because it contained a silver halide emulsion, see Column 81, line 65 - Column 84, line 44.

Specifically, the steps are as follows:

(a) Roughening both surfaces of support, and apply an undercoat to both surfaces

This Application (TA), page 242, line 10 to page 243, line 7
polyethylene terephthalate roughened by corona discharge then apply undercoat to both surfaces and dry.

Yoshioka (YO), Column 39, lines 39-53

PET roughened with corona discharge, apply an undercoat to both surfaces and dry.

Yamada (YA) Column 84, lines 35-37

PET film already had an undercoat of vinylidene chloride.

The purpose of the roughening step is to provide good bonding between the support and the undercoating. This roughening step does not affect the performance of the photothermographic material, so long as there is good bonding between the support and the undercoating.

(b) Roughening both surfaces of undercoat and apply a second undercoating.

TA, page 243, line 8 - page 244, line 3
YO, Column 39, lines 49-52   Back only
YA, Column 84, lines 37-38   Back only

(c) Coat one surface with a photosensitive layer comprising silver halide particles, an organic silver salt, a reducing agent, a compound of formula (1) (in some cases) and a compound of formula (2a) (in some cases).

TA, page 244, Line 4 - page 247, line 9
YO, Column 40, line 40 - Column 41, line 30,
Column 46, lines 46-48
YA, Column 81, line 65 to Column 84, line 5
Column 84, lines 39-41

(d) Apply a protective coating to both sides.

TA, page 247, line 10 - page 249, last line
YO, Column 45, line 55 - Column 46, line 35,
Column 46, lines 49-52
YA, Column 84, lines 10-21,
Column 84, lines 42-44

8. Although there are differences in the procedures, I am of the opinion that the procedures are similar enough that if the prior art was used for the basic photothermographic material, the same relative numbers would be obtained for each of the samples. In other words, Sample 702 would have been better than Sample 701 and Sample 704 would have been better than Sample 703.

It is declared by undersigned that all statements made herein of undersigned's own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the U.S. Code; and that such willful false statements may jeopardize the validity of this Application or any patent issuing thereon.

Narito Goto

Narito Goto

Dated: This 17th day of August, 2005.

DCL/mr